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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,094	02/25/2004	Chih An Yang	2019-0235P	8501
2292	7590	09/21/2005		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER ABRAHAM, FETSUM	
			ART UNIT	PAPER NUMBER
			2826	
DATE MAILED: 09/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/785,094

Applicant(s)

YANG, CHIH AN

Examiner

Fetsum Abraham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Final rejection**

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3 and 5 of U.S. Patent No. 6,756,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

The noise eliminating system in claim 1 is covered by claim 1 of the patent.

The chip comprising a guiding unit in connection with the power and grounding units and having two guiding devices of claim 1 are respectively covered by claim 1 and claim 3 of the patent.

The two terminals of the system and its connections with the guiding devices of claim 1 is covered by claim 5 of the patent, thus connection maintained through the connection unit of the system through the two connection ports it comprises.

Therefore, all claim 1 elements are represented by the above claims of the prior art.

Although there may be a slight variation in claim language between the two documents such as claim 5 of the patent disclosing detailed structural prospect of the connection between the system and the guiding devices and uses different expression "ports" rather than "terminals" as in the current application, it would have been obvious to one skilled in the art to conclude on the similarity of the structures since the specification teaches on the "devices" as being circuit distribution wires and distribution wires may have different physical structures including direct or indirect, trenched, lateral or vertical, or bridged or crossed-over, and that terminals are exchangeable expressions to ports in the art and both expressions express the routing of signal paths in a given circuit configuration (the prior art and the claimed circuit configurations).

As for claim 4, although the claim language specifically addresses the electrical path as to how the system is connected to the power and ground supplies making it clear that the connection path was via the guiding devices, such a connection is also indirectly represented by claim 1 of the patent because the noise eliminating unit is electrically connected to the so called connecting unit in the system which is connected to the guiding unit comprising two guiding devices in connection with the power and ground supplies through the unit comprising the devices.

As for the metal distribution layer of claim 5, the patent discloses that structure as being the "connecting ports" protruding through the openings to electrically connect the first and second guiding devices. Clearly, the connecting ports or films (in the pretext of

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the specific art) must be a conductor because its role is claimed to "electrically" connect two given nodes in the structure. Therefore, it would have been obvious to one skilled in the art to conclude that the connecting element in claim 5 of the patent was indeed a conductor. As for the metal being the conducting material in claim 5, it would have been obvious to one skilled in the art to use such a material from the varieties of known conductors in the art such as highly doped materials and silicides, since metals provide the most superior conductivity in the relationship.

As for claims 6,7, the openings in claim 5 of the patent must have been etched since the layer comprising the openings is the base layer for their formation. But as the depth of structure claims, "**product by process**" claims are directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685 and *In re Thorpe*, 227 USPQ 964, 966. Therefore, the way the product was made does not carry any patentable weight as long as the claims are directed to a device. Further, note that the applicant has the burden of proof in such cases, as the above case law makes clear. Also see MPEP 2113.

As for claims 8,9, claim 9 of the patent covers the claimed subject matter.

**THIS** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's comment

This application is a divisional of 10/407,231, which contained 19 claims out of which 14 claims were allowed. The original claims 10-13 seemed to have been cancelled in the life cycle of the application. Those claims may also have been the basis for this application.

For the record, a telephone call was twice made to the applicant's representative Mr. Joe McKinney on 9/13/05 and messages left twice on the telephone machine to discuss and verify the assumption. As a result, Attorney Hsu; Cheng-kang responded and both parties discussed the history and situation of the application. The examiner forwarded the following discussion: Although a restriction requirement may have been imposed on the parent application at the time of its examination that left over claims 10-13 for this application, the claims, however, were not presented in original form and claim 10 of the parent application is slightly different from claim 1 of this application. The concept of art in the claims, however, seemed to be close. Further, the examiner informed the attorney that the applicant had canceled claims 1 and 2 and qualitatively

amended claim 3 and claim 4 on 6/23/05, effectively converging them into the original claims that were allowed and patented.

Therefore, the amended claims no longer represent the original claims 10-13 that paved the grounds for this application. In light of this reality, a double patenting rejection has been provided and the action is final because the claims were amended.

Agreement was reached between applicant's representative and the examiner on the fact that a terminal disclaimer could overcome the rejection and the double patenting rejection imposed on the amended claims were positively accepted by the applicant's representative irrespective of this application being the divisional of the parent application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fetsum Abraham whose telephone number is: 571-272-1911. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J Flynn can be reached on 571-272-1915.

Fetsum Abraham



913/05